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PATENT

in the united states patent and trademark office

In re application of

ECCLES, Additiony

Examiner:

Margery S. Phipps

Sexial No.:

08/637,802

Art Unit:

1742

Filed:

May 8, 1996

SILVER ALLOY COMPOSITIONS

Attorney Docket No.

C-35469

### DECLARATION UNDER RULE 132

Hon. Commissioner of Patents and Trademarks Washington, D.C. 20231

September 14, 1998

In 1963, I, Anthony Phillip Eccles, established Apecs Investment Castings Pry. Ltd., which specializes in custom casting of precions metals for the jewelry industry. Since 1963 I have been actively involved in the research and development of precious metal alloys for east and wrought products in all carst sand gold and silver alloys including several special purpose alloys, and eliver alloy compositions suitable for jewelry, flatware, and coinage. I was admitted to the Gold and Silver Smiths Guild of Australia in 1988, was invited to present a paper on jewelly technology at the Santa Fe Symposium in 1996, was recognized with an award for Industry Leadership by the Symposium in 1997, and published a paper on precious messi alloys emitted "Gold Technology" by The World Gold

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ECCLES, Anthony Phillips Serial No. 08/637,802 September 14, 1998 Page 2

Council. I am correctly the Managing Director of Apecs Investment Castings Pty. Ltd. and responsible for all aspects of the company's comming precious metal research program.

Apecs Investment Casting Pty. Ltd. was the first to successfully east and market in 1966, precious metal alloys that contained silicon. In 1970 Apres Investment Casting Pty. Ltd. gave its formula for gold alloys containing efficen to the Worshipful Company of Goldsmiths in London for industry analysis and assessment, and in 1993 Apres investment Casting Pty. Ltd. developed a range of cadminm free precious metal solders.

### LONG FELT BUT UNRESOLVED NEED

Sterling silver, near sterling silver, and other high silver concentration alloys have been commercially manufactured for the jewelry, houseware, and minting industries for centuries and have been available on a wide scale at least since the beginning of this century. Many new compositions of these high silver coment alloys have been manufactured over the years in order to fulfill particular needs.

Fire scale resistant silver alloys first appeared in the industry in 1970. Elements such as nickel, cadminin, zinc, and silicon, have been used over the years, and some are still used today as additives to high silver content silver alloys in order to improve the fire scale resistance of the alloys which will undergo hear resource during post melt processes, as are required during jewelry making etc. Essentially, U.S. Patent No. 5,039,479 Bernhard et al., filed September 1990, teaches a high silver content silver alloy

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Received Event (Event Succeeded) 9/16/98 Date: Time: 312 922 7747 28 Sender: Pages: Subject: Fax Number: SEP. 16. 1998, 4:24PM DVORAK & ORUM 1998Fay-15 NO. 5185,1 P. 19/28 05/09 Company: 312 927/P947 FROM .: P1ZZEYS/BR18BANE 61 7 \$494 9641 \$532 P.08/05 DEC. 14 1990 3:0910 NANKYU P OKOW NO. 5123 P. 23/29 ECCLES, Authory Phillips Serial No. 08/637,802 September 14, 1998 Page 3 composition exhibiting increased firescale resistance as is desirable for fine silver applications. The Bernhard 479' patent is owned by United Precious Metal Refining Company Inc. (United Precious Metal) of Alden, New York, which is a major manufacturer of jewelry grade and other high silver concentration alloys for the jewelry, houseward, flarways and minning industries. United Precious Metal's 479' patent advanced the company's manufacturing of its sterling silver alloy compositions, however, this alloy was seriously limited in its suitability for jewelry manufacturing because of its relatively soft consistency which is not hard enough for practical jewelry making.

United Precious Metal, as early as September 1990, fully appreciated that it had an interest and desire in developing a high sliver content sliver copper alloy exhibiting superior fire scale resistance, as well as a hardness skin to standard jewelry sliver alloys. Though possessing the means and motivation to increase the work hardenability of its fire scale resistant sliver alloy, United Precious Metal failed on their own to find a solution for several years after the filing of their 479° patent.

At a Santa Fee Symposium held in early 1993, I attended a meeting with Mel Bernbard of United Precious Metal who was familiar with my work in incorporating allicon additives to precious metals. At this meeting, I was given the task of reviewing the problems associated with increasing the work hardenability of United Previous Metals' parented sterling silver alloy, and coming up with a solution to improve the bardness of this silver alloy. I discovered that by adding trace amounts of germanium to the high silver.

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low copper alloy of the 479 patent, the germantom, as it is believed, would remain in solid solution during post melt hot processing, increasing the hardenability of the alloy over other tire scale resistant silver alloys. This new sterling or near sterling silver alloy became the preferred sterling silver alloy among Apecs customers. I applied for an Australian patent on my new silver alloy composition on November 15, 1993, and filed a PCT application for my composition on June 27, 1994.

#### COMMERCIAL SUCCESS

LICENSE AGREEMENT BETWEEN UNITED PRECIOUS METAL REFINING COMPANY INC. AND APECS INVESTMENT CASTINGS PTY. LTD.

The silver alloy composition of the claimed invention had the properties songht affect by United Precious Metal and was capable of passing rigorous acceptance tests, including tests for appearance, fire smin resistance, work hardenability, and usefulness and suitability for jewelry manufacture.

United Preajous Metal was deligited to be advised of the successful development of the present invention by Apecs Investment Castings, and was sufficiently confident in the Apecs sliver alloy so that United Precious Metal entered into a License Agreement with Apecs Investment on July 1994. Royalties and a down payment were made for this particular patent application for the desirable sliver alloy compositions of the claimed invention.

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United Precious Metal has increased its sale of sterling silver alloys by at least 80%. since 1995. The April silver alloy compositions account for 62% of the sterling silver alloys sold by United Precious Metal so far in 1998. This percentage is up from 36% of the total sterling silver alloys sold by United Precious Motal in 1995, the first full year under the license agreement. United Precious Metal has provided a letter to Apecs dated August 10, 1998, stating that "the introduction of Apecs' developed formula increased the hardness of the silver product and became the preferred metal of choice of United Precious Meral customers." A copy of the above referenced letter is attached.

In my opinion, the commercial success as demonstrated by the license of the inclinology of the present invention to a significant manufacture of fire scale resistant silver alloys for the jewelry industry, along with the significant increase in sales of their silver alloys made according to the Apecs compositions, is evidence that the combination of elements in the silver alloy compositions of the present invention are novel and nonobvious.

Anthony Philip-Eccles

of August 1998, before me personally appeared Anthony Phillip

Eccles, to me known and known to me to be the individual described in and who executed

the foregoing instrument, and who thereupon acknowledged to me that he executed the

same for the purposes therein set forth.

ROB

Name of Notary

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August 10, 1998

To: Apacs Investment Casting Pty Ltd.

Re: Sterling Silver

Dear Tony.

In regards to your request for additional information regarding the Brite Silver, I bave the following.

United Precious Metal Retining, Inc. was incorporated in 1988. At the time of incorporation United Precious Metal Refining, Inc. had a specialty in the development and manufacture of master alloys for karated gold. This expentise was extended to the development of silver master alloys for which United Precious Metal Refining, Inc. was granted 2 U.S. patents, #4,973,446 and #5,039,479. These patents advanced the productivity of sterling silver manufactures and gained commercial acceptance. The main drawback was relative softness. The introduction of Apoca developed formula increased the hardness of the silver product and became the preferred metal of choice of United Precious Metal Refining's customers.

The unit sales volume's are as follows:

	Apecs ·	Total United Silver	Percentage Apeca
1995	160,043 T/oz.	447,470 T/02	35.7 %
1996	242,250 T/oz.	632,359 T/02	38.3 %
1997	423,442 T/oz.	816,759 T/02	51.8 %
1998	495,837 T/oz.	800,141 T/02	61.9 %

As you can see the percentage has grown every year as the Apecs formula has been offered, compared to the United products.

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